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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,392	05/04/2005	Karl-Heinz Schwonke	Q82965	5710
23373 7590 10/01/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
LONEY, DONALD J				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
10/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,392

Applicant(s)

SCHWONKE ET AL.

Examiner

Donald Loney

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 17, the cover layer is recited as smooth. This appears in direct contrast with claims 10 and 26 which recite the cover layer as embossed on the outside? The applicant also argues, on page 8, second to the last paragraph in the response filed July 16, 2009, that the prior arts cover will never be smooth since it is structured (i.e. embossed). Therefore, the applicant may be referring to the cover as being planar, however, this also would conflict with embossments on the outside.

Therefore, it is unclear as to what the applicant means by "smooth". Clarification and/or correction is kindly requested.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11 and 14-33 are rejected under 35 U.S.C. 102(b) as being anticipated by either Wiley et al (4409280) or Martin et al (5773127) as presented in the last office action, mailed December 11, 200.

Both Wiley et al and Martin et al disclose a base which is embossed and a cover layer there over which has the embossed pattern transferred to the cover layer. See figure 3 in Wiley et al showing base layer 3" and PVC cover layer 5 and figure 5 in Martin et al showing base layer 13 and clear PVC layer(s) 21 and 27 thereon. With regards to claims 4, 5, 20 and 21 wherein there is another layer between the base and cover layer. See layer 21 and 27 in Wiley et al and layers 3' and 5 in Martin et al. Regarding claims 2, 3, 18 and 19, printing is shown between the layers in both references. With regards to claim 7 and 22, the base is formed of more than two films as shown in the figures.

6. Claims 1, 6, 7, 8, 17, 22, 23, 24, 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Balmer et al (5102716).

Balmer et al discloses a flooring material comprising an embossed base layer 4 and a clear PVC layer 8 there over wherein the embossed pattern 6 formed in the base is transferred 10 to the cover layer and wherein the cover layer has a smooth, and planar, surface. Refer to figure 1 along with column 6, lines 12-16 and claim 1. This rejection is being made to specifically address the smooth limitation and it being meant to be planar as indicted above since it is unclear as to what the applicant means thereby (see 35 USC 112 rejection above). With regards to claims 6-8, and 22-24, the layer(s) are all what can be considered film(s) and the base can be two layers 2 and 4. With regards to claims 27 and 29, the processes uses rollers with heat and/or pressure (see column 7, lines 58-68).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Wiley et al or Martin et al as presented in the last office action, mailed December 11, 2008.

The primary reference teaches the invention substantially as recited except for the specific profile dimensions of the embossments per claims 12 and 13. They are silent as thereto. See the 35 U.S.C. 102 rejections above.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the embossments of the recited profile dimensions since this would merely involve a change in size and/or shape which is generally within ordinary skill in the art. See MPEP 2144.04IV.

Response to Arguments

11. Applicant's arguments filed July 16, 2009 have been fully considered but they are not persuasive. The applicant argues that since the cover layers in Wiley et al and Martin are structured (i.e. embossed) that they will never be smooth. This is not

persuasive since something can be embossed and smooth. As indicted above, it is unclear as to what the applicant means by smooth. The applicant themselves emboss the outer surface of the cover per claims 10 and 26 as indicated above. Therefore, the limitation of smooth does not structurally distinguish from the prior art, even if it is embossed because the applicant also embosses the outer surface of the cover.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Donald J. Loney/
Primary Examiner
Art Unit 1794

DJL;D.Loney
09/29/09